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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/690,136 07/31/96 BRADY

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EXAMINER

EASHOO, M

ART UNIT

PAPER NUMBER

1732

20

DATE MAILED:

07/23/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/690,136

Applicant(s)

BRADY ET AL.

Examiner

Mark Eashoo, PhD.

Group Art Unit

1732

☒ Responsive to communication(s) filed on 12 May 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 12-28 is/are pending in the application.

Of the above, claim(s) 19-28 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 12-18 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 18

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

## DETAILED ACTION

### *Election/Restriction*

1. Newly submitted claims 19-28 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 12-18, drawn to a method of producing a polymeric film, classified in class 264, subclass 210.2.
  - II. Claims 19-28, drawn to a polymeric film, classified in class 428, subclass 411+.
3. The inventions are distinct, each from the other because of the following reasons: Inventions of group I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the process as claimed can be used to make other and materially different product such as single layered film.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-28 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### *Claim Rejections - 35 U.S.C. § 112*

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 recites the limitation "multiple film thickness" which is indefinite and/or confusing because it is not understood whether Applicant is claiming that the embossing produces various different film thicknesses throughout the film or if the pattern itself is of multiple film thickness. For the purpose of further examination, the limitation "multiple

film thickness" has been interpreted as different film thicknesses as described in the instant specification at the top of page 11.

***Claim Rejections - 35 U.S.C. § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
  1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 12 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheth (US Pat. 4,777,073) in view of Schwarz (US Pat. 4,116,892).

Scope and Content of Sheth: Sheth teaches the instantly claimed process for producing a film having a WVTR greater than 200 g/m<sup>2</sup>/day, comprising: extruding and stretching a precursor film (1:55-57 and Examples 1-2); a polyolefin precursor film (2:4-22) having a CaCO<sub>3</sub> filler wherein the film is 15-65% filler by weight (2:52-3:2); a polyolefin blend made from polypropylene, copolymers of propylene, homopolymer and copolymers of ethylene(1:60-2:3); films having a WVTR above 1000 g/m<sup>2</sup>/day (6:50-60); embossing a pattern of different thicknesses prior to stretching the film (1:55-57 and 4:15-26); and various film compositions including an elastomer (5:42-53).

It is noted that the instant claims recite a filler content of 20-250 parts per hundred parts of polyolefin. The art conventionally measures these "parts" by weight. Thus, 20-250 parts per hundred parts of polyolefin is about 16-71% by weight filler which is in the range taught by Sheth.

Differences between Sheth and Claims 12, 15-18: Sheth does not teach passing a precursor film between a pair of interdigitating grooved rollers.

Level of Ordinary Skill in the Pertinent Art: A person having ordinary skill in the pertinent art that is instantly claimed includes knowledge of the basic techniques for forming polymeric films including oriented films, physical properties of various polymers and blends thereof, the effect of fillers in films, and various techniques of measuring film properties. This is not a complete list of all knowledge possessed by one of ordinary skill in the pertinent art.

Scope and Content of Schwarz: Schwarz teaches stretching a film formed from a blend of thermoplastic orientable polymer and an inorganic material (ie. a filler) between interdigitating/intermeshed grooved rollers to form a porous film (2:11-40, 3:10-11 and Figs. 1-5).

Consideration of the Evidence/Prior Art: Sheth and Schwarz are from the same field of endeavor, namely the production of stretched polymeric films having a filler therein. At the time of invention, a person having ordinary skill in the art would have found it obvious to have used the interdigitating grooved rollers, as taught by Schwarz, and therefor modified the process of Sheth, because Schwarz suggests (ie. provides motivation to combine) that grooved roll drawing/stretching permit multiple simultaneous draw necks which causes a fibrillation phenomenon which is highly desirable for porous films. A reasonable chance of success would have been expected by a person having ordinary skill in the art if the stretching of Sheth were preformed by the interdigitating grooved rollers of Schwarz because common materials are used in the film of each reference, namely, polypropylene.

All recited limitations of instant claims 12 and 15-18 are taught/rendered obvious by the combination of Sheth and Schwarz.

10. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sheth (US Pat. 4,777,073) in view of Schwarz (US Pat. 4,116,892) as applied to claims 12 and 15-18 above, and further in view of JP 48-060774.

Scope and Content of Sheth & Schwarz: See above paragraph 9.

Level of Ordinary Skill in the Pertinent Art: See above paragraph 9.

Differences between Sheth in view of Schwarz and Claims 13-14: Sheth does not teach the specific elastomer instantly claimed or the amount of an elastomer present in a film.

Scope and Content of JP 48-060774: JP 48-060774 teaches a porous, stretched polyolefinic film comprising 5-100 pph high styrene rubber and a  $\text{CaCO}_3$  filler.

Consideration of the Evidence/Prior Art: Sheth and JP 48-060774 are from the same field of endeavor, namely the production of stretched polyolefin films having a  $\text{CaCO}_3$  filler therein. At the time of invention, a person having ordinary skill in the art would have found it obvious to have added 5-100 pph of high styrene rubber, such as either well known styrene-isoprene-styrene or styrene-butadiene-styrene elastomers, as taught by JP 48-060774, and therefor modified the process of Sheth, for the benefit of adding impact strength or pliability to the film. The motivation for adding a high styrene rubber to a polyolefin film to add impact strength or pliability to the film is derived from knowledge generally available to a person having ordinary skill in the art since it is well known that elastomers provide such properties. A reasonable chance of

success would have been expected by a person having ordinary skill in the art if the high styrene rubber of Sheth were used by the process of Schwarz because common materials are used in the film of each reference, namely, polyolefins and  $\text{CaCO}_3$ .

All recited limitations of instant claims 13 and 14 are taught/rendered obvious by the combination of Sheth and Schwarz in further view of JP 48-060774.

#### *Response to Arguments*

11. Applicant's arguments with respect to claims 12-28 have been considered but are moot in view of the new ground(s) of rejection. However, it is noted that Applicant's remarks have been substantially responded to by the new rejection.

#### *Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### *Correspondence*

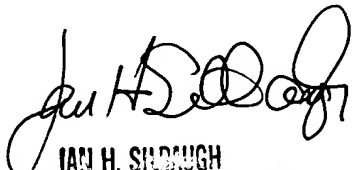
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo at (703) 308-3606. The examiner can normally be reached on Monday through Friday from 8:00 am to 3:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Silbaugh, can be reached on (703) 308-3829. The facsimile number for Art Unit 1732 is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist for Technology Center 1700, whose telephone number is (703) 308-0661.

Mark Eashoo, Ph.D.  
Assistant Examiner, Art Unit: 1732

me

July 22, 1999

  
JAN H. SILBAUGH  
SUPERVISORY PATENT EXAMINER  
ART UNIT 1732

07/22/99